



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,581	01/05/2001	Nobumasa Miyake	09812.0593-00000	3808

22852 7590 08/21/2006

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

BRUCKART, BENJAMIN R

ART UNIT	PAPER NUMBER
----------	--------------

2155

DATE MAILED: 08/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/755,581

Applicant(s)

MIYAKE ET AL.

Examiner

Benjamin R. Bruckart

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-17 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Detailed Action

Status of Claims:

Claims 1-17 are pending in this Office Action.

Claims 1, 4, 5, and 9 are amended.

Claims 10-17 are new.

The 35 U.S.C. 112, second rejection is withdrawn in light of applicant's amendment.

Response to Arguments

Applicant's arguments filed 6/23/06 have been fully considered but are moot in view of the new ground(s) of rejection.

Applicant's invention as claimed:

Claims 1-9, 12-14, 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable by U.S. Patent No. 6,012,088 by Li et al in view of U.S. Patent No. 6,130,892 by Short et al.

Regarding claim 1, the Li reference teaches a method of setting up an Internet server (col. 3, lines 24-38), comprising the steps of:

receiving by an Internet service provider, from a client, information on a connecting environment of the Internet server (col. 3, lines 30-34);

generating by the Internet service provider, connection setup information for the connecting environment to enable the Internet server to be connected to the Internet according to the connection setup information (col. 3, lines 34-38); and

storing by the Internet service provider, the connection setup information in a storage medium (col. 9, lines 50-59); and

wherein the connection setup information allows the client to have the Internet server set up for Internet access (col. 9, lines 56- col. 10, line 5).

The Li reference fails to teach detecting differences between current and stored connection setup.

However the Short reference teaches a connection setting processing procedure detects current connection setup information (Short: col. 12, lines 31-65), detects a difference between the current connection setup information on the server and the connection setup information stored on the locally installed storage medium (Short: col. 11, lines 43-56; col. 13, lines 15-42) and updates the connection setup information stored on the locally installed storage medium in accordance with the current connection setup information stored on the server (Short: col. 9, lines 36-47) in order to prevent users from having to reconfigure their devices connections (Short: col. 2, lines 52-62).

It would have been obvious at the time of the invention to one of ordinary skill in the art to create the method of setting up an Internet server as taught by Li to include the detecting changes in connection setup as taught by Short in order to prevent users from having to reconfigure their devices connections (Short: col. 2, lines 52-62).

Examiner takes Official Notice (see MPEP § 2144.03) that "transferring data on a storage medium and a client locally installing the storage medium" in a computer networking environment was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position". However, MPEP § 2144.03 further states "See also In re Boon, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, In re Boon, 169 USPQ 231, 234 states "as we held in Ahlert, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice

Art Unit: 2155

means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

Regarding claim 2, the method of setting up an Internet server according to claim 1, wherein said connection setup information includes at least one IP address of said Internet server, host name and domain name of a client (Li: col. 3, lines 54-61).

Regarding claim 3, the method of setting up an Internet server according to claim 1, wherein said locally installable storage medium stores a unique password pertaining to said Internet server that enables setup processing for said Internet server when said password matches an initial password which is set up in said Internet server (Li: col. 10, lines 66- col. 11, line 16).

Regarding claim 8, the method of setting up an Internet server according to claim 1, wherein said connection setting processing procedure is performed automatically upon detection of the change of said connection setup information (Short: col. 9, lines 36-47).

Regarding claim 12, the method of setting up an Internet server according to claim 1, wherein more than one client computer can connect to the internet through the server (Li: col. 6, lines 34-41).

Regarding claim 13, the method of setting up an Internet server according to claim 1, further comprising the step of updating the connection setup information on the server by a client computer connected to the server through a network (Short: col. 9, lines 36-47).

Regarding claim 4, the Li reference teaches a method of setting up an Internet server (col. 3, lines 24-37), comprising the steps of:

sending to an Internet service provider, by a client, information on a connecting environment of the Internet server (col. 3, lines 31-38; col. 9, lines 26-58);

receiving from the Internet service provider, by the client, connection setup information corresponding to the connecting environment (col. 11, lines 5-30);

performing connection set up processing to connect the Internet server to the Internet (col. 11, lines 5-30);

The Li reference fails to teach detecting differences between current and stored connection setup.

However the Short reference teaches a connection setting processing procedure detects current connection setup information (Short: col. 12, lines 31-65), detects a difference between the current connection setup information on the server and the connection setup information stored on the locally installed storage medium (Short: col. 11, lines 43-56; col. 13, lines 15-42) and updates the connection setup information stored on the locally installed storage medium in accordance with the current connection setup information stored on the server (Short: col. 9, lines 36-47) in order to prevent users from having to reconfigure their devices connections (Short: col. 2, lines 52-62).

It would have been obvious at the time of the invention to one of ordinary skill in the art to create the method of setting up an Internet server as taught by Li to include the detecting changes in connection setup as taught by Short in order to prevent users from having to reconfigure their devices connections (Short: col. 2, lines 52-62).

Examiner takes Official Notice (see MPEP § 2144.03) that "transferring a locally installable storage medium and a client locally installing the storage medium" in a computer networking environment was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position". However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the

assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

Regarding claim 16, the method of setting up an Internet server according to claim 4, wherein more than one client computer can connect to the internet through the server (Li: col. 6, lines 34-41).

Regarding claim 17, the method of setting up an Internet server according to claim 4, further comprising the step of updating the connection setup information on the server by a client computer connected to the server through a network (Short: col. 9, lines 36-47).

Regarding claim 5, the Li reference teaches a method of setting an information communication apparatus for connecting to a network (Li: col. 3, lines 24-37), said method comprising:

- a first step of storing in a storage medium of an Internet service provider, connection setting information for connecting said information communication apparatus to said network in a use environment of said information communication apparatus on the side of a client (Li: col. 9, lines 50-60);

- a third step of reading, the connection setting information from the storage medium to initialize the connection of the information communication apparatus to the network;

The Li reference fails to teach detecting differences between current and stored connection setup.

However the Short reference teaches a connection setting processing procedure detects current connection setup information (Short: col. 12, lines 31-65), detects a difference between the current connection setup information on the server and the connection setup information stored on the locally installed storage medium (Short: col. 11, lines 43-56; col. 13, lines 15-42) and updates the connection setup information stored on the locally installed storage medium in

accordance with the current connection setup information stored on the server (Short: col. 9, lines 36-47) in order to prevent users from having to reconfigure their devices connections (Short: col. 2, lines 52-62).

It would have been obvious at the time of the invention to one of ordinary skill in the art to create the method of setting up an Internet server as taught by Li to include the detecting changes in connection setup as taught by Short in order to prevent users from having to reconfigure their devices connections (Short: col. 2, lines 52-62).

Examiner takes Official Notice (see MPEP § 2144.03) that "storing information in a local storage medium and transferring the storage medium" in a computer networking environment was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position". However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

Regarding claim 6, the method of setting an information communication apparatus according to claim 5, wherein

said first step stores a unique password in said storage medium together with said connection setting information (Li: col. 10, lines 66- col. 11, line 16); and

said second step compares said password with a password previously set in said information communication apparatus, and connects said information communication apparatus

to said network when said password matches the password previously set in said information communication apparatus (Li: col. 10, lines 66- col. 11, line 16).

Regarding claim 7, the method of setting an information communication apparatus according to claim 6, wherein

said storage medium comprises a semiconductor memory removable mountable to said information communication apparatus (Short: col. 9, lines 36-48).

Regarding claim 9, The Li reference teaches a method of setting up a network server (col. 3, lines 24-37) comprising the steps of:

receiving, by an Internet service provider, from a client, information on connection environment relating to the network server (Li: col. 3, lines 31-38);

generating by the Internet service provider, connection setup information for the connecting environment to enable the network server to be connected to the network according to the information (Li: col. 3, lines 34-38);

storing by the Internet service provider, the setup information in a storage medium (Li; col. 9, lines 50-57); and

wherein the setup information allows the client to have the network server set up for network access (Li: col. 6, lines 34-41).

The Li reference fails to teach detecting differences between current and stored connection setup.

However the Short reference teaches a connection setting processing procedure detects current connection setup information (Short: col. 12, lines 31-65), detects a difference between the current connection setup information on the server and the connection setup information stored on the locally installed storage medium (Short: col. 11, lines 43-56; col. 13, lines 15-42) and updates the connection setup information stored on the locally installed storage medium in accordance with the current connection setup information stored on the server (Short: col. 9, lines 36-47) in order to prevent users from having to reconfigure their devices connections (Short: col. 2, lines 52-62).

It would have been obvious at the time of the invention to one of ordinary skill in the art to create the method of setting up an Internet server as taught by Li to include the detecting changes in connection setup as taught by Short in order to prevent users from having to reconfigure their devices connections (Short: col. 2, lines 52-62).

Examiner takes Official Notice (see MPEP § 2144.03) that "transferring a storage medium to a client and locally installing the storage medium" in a computer networking environment was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position". However, MPEP § 2144.03 further states "See also In re Boon, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, In re Boon, 169 USPQ 231, 234 states "as we held in Ahlert, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

Claims 10, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable by U.S. Patent No. 6,012,088 by Li et al in view of U.S. Patent No. 6,130,892 by Short et al in further view of U.S. Patent No. 2002/0032782 by Rangan et al.

Regarding claim 10, the Li reference teaches the method of setting up an Internet server according to claim 1. The Li reference fails to teach a storage medium installed on a server.

However the Rangan reference teaches the steps of the server denying access to the internet (Rangan: page 1, para 12) unless:

the storage medium is installed in the server (Rangan: page 5, para 48); and
a password stored in the storage medium matches a password stored in the
Internet server (Rangan: page 4, para 37) in order to authenticate users and give them access to
all services (page 2, para 3-4)

It would have been obvious at the time of the invention to one of ordinary skill in the art
to use the method of setting up and Internet server as taught by Li to include a storage medium
with a password as taught by Rangan in order to authenticate users and give them access to all
services (page 2, para 3-4).

Regarding claim 14, the Li reference teaches the method of setting up an Internet server
according to claim 4. The Li reference fails to teach a storage medium installed on a server.

However the Rangan reference teaches the steps of the server denying access to the
internet (Rangan: page 1, para 12) unless:

the storage medium is installed in the server (Rangan: page 5, para 48); and
a password stored in the storage medium matches a password stored in the
Internet server (Rangan: page 4, para 37) in order to authenticate users and give them access to
all services (page 2, para 3-4)

It would have been obvious at the time of the invention to one of ordinary skill in the art
to use the method of setting up and Internet server as taught by Li to include a storage medium
with a password as taught by Rangan in order to authenticate users and give them access to all
services (page 2, para 3-4).

**Claims 11, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable by U.S.
Patent No. 6,012,088 by Li et al in view of U.S. Patent No. 6,130,892 by Short et al in
further view of U.S. Patent No. 5,623,637 by Jones et al.**

Regarding claim 11, the Li reference teaches the method of setting up an Internet server
according to claim 1. The Li reference fails to teach denying access unless passwords match.

Art Unit: 2155

However the Jones reference teaches a step of denying access unless a user enters a password matching a password on the storage medium (Jones: col. 5, lines 54- col. 6, line 4) in order to store data against unauthorized access (Jones: col. 1, lines 65- col. 2, line 4).

It would have been obvious at the time of the invention to one of ordinary skill in the art to use the method of setting up and Internet server as taught by Li to include a storage medium with a password as taught by Jones in order to store data against unauthorized access (Jones: col. 1, lines 65- col. 2, line 4).

Regarding claim 15, the Li reference teaches the method of setting up an Internet server according to claim 4. The Li reference fails to teach denying access unless passwords match.

However the Jones reference teaches a step of denying access unless a user enters a password matching a password on the storage medium (Jones: col. 5, lines 54- col. 6, line 4) in order to store data against unauthorized access (Jones: col. 1, lines 65- col. 2, line 4).

It would have been obvious at the time of the invention to one of ordinary skill in the art to use the method of setting up and Internet server as taught by Li to include a storage medium with a password as taught by Jones in order to store data against unauthorized access (Jones: col. 1, lines 65- col. 2, line 4).

REMARKS

Applicant has amended the claims to clarify the storage medium is a removable and is transferred from the ISP to the client.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin R Bruckart whose telephone number 571-272-3982.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications and after final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the examiner whose telephone number is 571-272-3982.

Benjamin R Bruckart
Examiner
Art Unit 2155

BRB


SALEH NAJJAR
SUPERVISORY PATENT EXAMINER